

a. a lightweight, flexible fiberoptic bundle including several optical cables and having an input end and an output end, the input end being adapted for connection to a remote illumination source;

b. a small, light weight housing including an input end having an interior surface that defines a light guide opening and an output end having an interior surface that defines an illumination opening, the output end of the fiberoptic bundle extending within the light guide opening and being aligned so that light therefrom illuminates the illumination opening,

c. only a single lens mounted within the interior surface of the output end of the housing, thereby providing a light source of such weight and size that it may be mounted to headgear so that an illumination beam therefrom substantially corresponds to the user's line of sight; and

d. means for attaching the housing to the headgear.

#### REMARKS

This amendment is responsive to the non-final Official Action mailed September 4, 2002. Claims 1-56 are currently pending, with claims 23 and 56 having been cancelled and claims 28, 31, 33, 34, 35 and 55 having been amended. Applicant notes and appreciates the Examiner's indication that claims 1-22, 24-27 and 33-53 are allowable. In view of the foregoing amendments, as well as the following remarks, Applicants respectfully submit that this application is in complete condition for allowance and request reconsideration of the application in this regard.

Claims 54-56 stand rejected under 35 U.S.C. § 251 as being an improper capture of broadened subject matter surrendered in the application for the patent upon which the present reissue is based. Each of these claims is an independent claim, of which Applicants have elected to cancel independent claim 56. Applicants respectfully traverse the rejection of claims 54 and 55 for the reasons set forth below.

Under the two step test for impermissible recapture set forth in MPEP § 1402.02, the limitation being omitted in the present reissue must have been originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application. In the prosecution history of the original application file, Applicants amended the claims to recite an “aspheric” lens. The Examiner concludes that the limitation of an aspheric lens, as added to claims 1 and 7 of the application as originally filed, was to distinguish over the art of record. Applicants respectfully disagree.

The Federal Circuit has mandated that “[t]o determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.” In re Clement, 131 F.3d at 1469, 45 USPQ2d at 1164 (Fed. Cir. 1997). Therefore, the Examiner must also consider Applicants’ remarks and is prohibited from presuming in a vacuum that a change to the claims was made to overcome the prior art rejection.

Applicants’ remarks accompanying the amendment adding the aspheric lens limitation argued that the prior art reference (Li et al.) upon which the rejection was based disclosed an “achromatic lens” that is “a combination of two or more spherical

lenses having different focal lengths" that are "cemented directly together or with an air space between them." See Communication to Examiner (dated as received by AU 3400 by fax copy on Sept. 10, 1996) at page 4. Applicants also remarked that an achromatic lens is "formed of at least two separate lenses" and is "more expensive than an integral lens (i.e., a molded *single* lens)." *Id. (emphasis added)*. Applicants' further argued that Li et al. failed to teach or suggest "an aspheric lens, much less *any lens* other than an achromat lens." *Id (emphasis added)*. Applicants argued that "apart from Li et al., all other known references teach the use of multiple lenses, mirrors or prisms to focus light into a well-sized spot." *Id.* at page 7. By way of further clarification, Applicants remarked that Li et al. discloses a single lens (*insofar as the compound-lens achromat can be considered a "single lens"*). *Id.* at page 7 (*emphasis added*).

Applicants respectfully submit that the preceding remarks in the Communication to Examiner do not indicate that the "aspheric" limitation was added to make the claims allowable over a rejection based upon Li et al. or to make the claims allowable over other art of record in the original application. Instead, Applicants contemporaneous remarks clearly evidence that Li et al. discloses an achromatic lens having two or more lenses, as contrasted with a single lens. Specifically, Applicants expressly remark that Li et al. discloses a structure having two or more lenses, as contrasted with an integral lens or a molded single lens, and that Li et al. fails to teach any lens other than an achromatic lens having two or more lenses, of which an aspheric lens qualifies as any lens. This statement does not suggest that Applicants considered that the claimed single lens must be aspheric to be distinguishable over Li et al. but, instead, suggests that an aspheric-type lens is a type of single lens. Applicants further remark that "apart

from Li et al., all other known references teach the use of multiple lenses, mirrors or prisms to focus light into a well-sized spot." However, Applicants clarify this statement by subsequently remarking that Li et al. only discloses a single lens insofar as a compound-lens achromat can be considered a "single lens". Therefore, Applicants submit that the record of the original application unambiguously indicates that the broadening aspect (the omitted/ broadened limitation of "aspheric") is not subject matter that Applicants previously surrendered. Therefore, the rejection of claims 54 and 55 is not proper and Applicants respectfully request that this rejection of these claims be withdrawn.

Claims 23, 28/23, 29/28/23, 31/23, 32/31/23 and 54-56, of which claims 23, 54, 55 and 56 are independent, stand rejected as being anticipated under 35 U.S.C. § 102(e) by Li et al. (5,430,620). Applicants have elected to cancel independent claim 23 and have made corresponding amendments to the various dependent claims so that each depends either directly or indirectly from a corresponding one of allowed independent claims 21 and 22. Applicants have also elected to cancel independent claim 56.

With regard to independent claims 54 and 55, Applicants respectfully submit that Li et al. discloses an achromatic lens, which is a combination of two or more lenses having different focal lengths that are cemented directly together or with an air space between them. In contrast, Li et al. does not teach or disclose a single lens, as recited in each of claims 54 and 55. Moreover, Li et al. does not suggest that the achromatic lens may be replaced with a single lens. Although Li et al. states that various optics may be implemented for collecting and concentrating the light rays exiting the

illuminator, Li et al. does not provide an unambiguous motivation or suggestion to replace the achromatic lens with a single lens. Therefore, Applicants respectfully request that the rejection of claims 54 and 55 be withdrawn.

## CONCLUSION

Applicants have made a bona fide effort to respond to each and every requirement set forth in the Office Action. In the event that any issues remain outstanding, the Examiner is invited to contact the undersigned to expedite issuance of this application.

Applicants do not believe there are any fees due in connection with filing this communication. If, however, additional fees are necessary as a result of this communication, the Commissioner is hereby authorized to charge any under-payment or fees associated with this communication or credit any over-payment to Deposit Account No. 23-3000.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

By: William R. Allen  
William R. Allen, Ph.D.  
Reg. No. 48,389

2700 Carew Tower  
Cincinnati, Ohio 45202  
(513) 241-2324